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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,184	09/10/2001	Signe Unverricht	211820US0PCT	9394
22850	7590	05/17/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,184

Applicant(s)

UNVERRICHT ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Final Rejection

The Status of Claims

Claims 1-31 are pending.

Claims 1-31 have been rejected.

Double Patenting

1. Applicants' argument filed 2/28/05 have been fully considered but are not persuasive.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of Claims 1-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No.

6,740,779 B1 has been maintained with the reasons of record on 11/30/04 due to applicants' failure to file the Terminal Disclaimer.

Applicants' Argument

2. Applicants argue the following issues:

a. The claimed process for the catalytic gas-phase oxidation of propene to acrylic acid which contains the following limitations , (i) " at least one inert gas which comprises at least 20 % by volume of molecular nitrogen" , (ii) " the acrolein contained in reaction as starting mixture 2 is >- 140 1 (STP) of acrolein/1 of catalyst bed-h " as claimed under e) , and (iii) " the reaction zone C extends to an acrolein conversion of from 55 to 85 mol% " as claimed in h) of claim 1 are absent in the claims of US 6,740,779.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the argument , the Examiner has noted applicants' arguments.

However, those limitations can be found in the specification below:

1. In the paragraph section 25 of the prior art, it says that "the inert gas used comprises 30 % by volume or 40 % by volume of molecular nitrogen" , which corresponds to "at least 20 % by volume of molecular nitrogen" as claimed in claim 1 ;

2. In the paragraph section 58 of the prior art, it says that " the acrolein loading of the fixed catalyst bed 2 is ,as a rule , frequently 20 or 25 1 (STP) of acrolein/1 of catalyst bed-h below the propene loading of the fixed catalyst bed 1" , which corresponds to " >- 140 1 (STP) of acrolein/1 of catalyst bed-h " as claimed under e) of claim 1 ; and
3. In the paragraph section 87 of the prior art, it says that " the reaction zone D extends up to a conversion of acrolein , of from 55 to 85 mol %" as claimed in h) of claim 1.

Furthermore, there are motivations to add those limitations to the claims:

First, with respect to (i) , propene loadings of the fixed catalyst bed 1 of from 165 1 (STP) to 250 1 of acrolein/1 of catalyst bed-h can be achieved surprisingly (paragraphs 24 and 25) when the inert gas comprised " 30 % by volume or 40 % by volume of molecular nitrogen " or more is used in the process;

Second, with respect to (ii), in the first reaction , both conversion and selectivity with respect to acrolein generally do not reach 100 %; therefore, it is good to specify what the acrolein loading of the fixed catalyst bed 2 can be during the process so as to optimize the process;

Third, with respect to (iii), the beginning of the reaction zone E is usually behind the hot-spot maximum of the reaction zone D ,which has a conversion of acrolein , of from 55 to 85 mol %"; therefore, it is good to specify what conversion of acrolein (in mol %) in the reaction zone D can be in order to

predict the conversion rate of the reaction zone E .

Therefore, it would have been obvious to the skilled artisan in the art to be motivated to add those limitations into the current claims in order to achieve a high propene loadings of the fixed catalyst bed 1 and to optimize the process ,and to predict the conversion rate of the reaction zone E in the process as guidances shown in the prior art.

Therefore, applicants' argument are irrelevant to the issue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Art Unit: 1625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*** Taylor V Oh
5/13/55


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